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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kia Silverbrook

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/575,197

Applicant(s)

SILVERBROOK ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-18, 20-31 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-18, 20-31, and 36-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/24/04 07/25/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-3, 8-18, 20-31, and 36-47 are pending. Claims 1-3, 8, 10, 12, 15, 18, 22, 24-27, 29-31, 36, and 41-43 have been amended in this communication filed 10/30/06 entered as Response After Non-Final Action.
2. The IDS filed 10/21/04 and 07/25/05 have been reviewed and submitted for the second time.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is ambiguous and unclear from the claim limitations how "a computer system can receive digital ink from an optically imaging pen with the digital ink containing data and generating digital ink using the coded data". It is not understood how a computer system can receive digital ink and the digital ink contain data. It is vague and unclear in the claim language how this can be performed.

Applicants' need to include in the claim limitations "the digital ink is a sequence of captured strokes". Otherwise one may not understand from the claim language this is what is meant by digital ink received from a computer system from an optically imaging pen with the digital ink containing data. My vision is with a computer holding digital ink

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some place in the computer and then the digital ink is dispersed on to paper containing data.

Claim 29 is rejected for a similar problem.

Claims 1, 26, and 29 contain a clause of intended use in the independent claims which renders the claims indefinite. Specifically, claim 1 in the second claim limitation recites "... wherein the pen, when placed in an operative position relative to the information, ...".

The Examiner considers these limitations to only recite what is expected to happen, a desired result, or an intended use. The MPEP discusses a type of limitation in reference to "whereby" clauses and discusses "wherein" clauses. MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

Claims 2, 3, 8-18, 20-28, 30, 31, and 36-47 are rejected because of their dependency on a rejected base claim.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser in view of (WO 99/66441) Buckley et al, hereafter Buckley.

Claims 1 and 29. Speiser discloses, A method of enabling payment of bills, the method including the steps of providing a bill, the bill containing human-readable information indicative of at least one parameter relating to a requested payment and coded data indicative of an identity of the bill and of a plurality of locations on the bill, the information and coded data having been printed substantially simultaneously, and at least some of the coded data being coincident with the information (page 6, paragraph 1- paragraph 3, and Fig. 1). Speiser failed to disclose, receiving, in a computer system, digital ink from an optical imaging pen, the digital ink containing data being indicative

of the identity of the bill and a position of the pen relative to the bill, wherein the pen, when placed in an operative position relative to the information, senses the corresponding coincident coded data and generates the digital ink using the sensed coded data identifying, in the computer system and from the digital ink, the at least one parameter relating to the requested payment. Buckley discloses, receiving, in a computer system, digital ink from an optical imaging pen, the digital ink containing data being indicative of the identity of the bill and a position of the pen relative to the bill, wherein the pen, when placed in an operative position relative to the information, senses the corresponding coincident coded data and generates the digital ink using the sensed coded data and identifying, in the computer system and from the digital ink, the at least one parameter relating to the requested payment (Page 4, lines 14-32, page 5, lines 30-38, page 7, lines 1-12 and 29-32, and page 8, line 1-page 9, line 6 and line 12-page 11, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made for the indicating data, the at least one parameter to be related to the requested payment and to modify in Speiser because such a modification would allow Speiser to know that the bill was paid in full and the consumer was given credit for paying the bill on time. The coded data being printed substantially, simultaneously is merely non-functional descriptive material per se and is not functionally involved in the steps recited. The steps of the method would be performed the same regardless of the coded data being printed substantially, simultaneously. Thus, the descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

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Claims 2 and 30. Speiser discloses, said at least one parameter relating to the requested payment is associated with at least one zone of the bill and in which the method includes identifying, in the computer system and from the zone indicated by the position of the sensing device as indicated by the digital ink, said at least one parameter (Page 6, paragraphs 3 and 4).

Claims 3 and 31. Spieser discloses, wherein the indicating data includes movement data indicative of movement of the pen relative to the bill, the pen having generated the movement data using at least some of the coded data, and wherein the at least one parameter is identified in the computer system by determining that the movement was at least partially within said at least one zone (Page 8, paragraph 1, Fig. 2 (24 and 30 – computers), (20 and 22- printers), and (36-reader) and Fig. 3B- shows the printing of computerized documents)).

8. Claims 8-14 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser and (WO 99/66441) Buckley et al, hereafter Buckley in view of (US 5,326,959) Perazza.

Claim 8. Spieser discloses, The method of claim 2 which the at least one parameter is an action parameter of the requested payment, the method including effecting, in the computer system, an operation in respect of the action parameter (Page 6, paragraph 1 and Page 7, paragraph 2).

Claims 9 and 37. Spieser discloses, the action parameter of the requested

payment is selected from the group comprising: requesting that payment be made, specifying a payment amount or resetting the bill to an original state (Page 8, paragraph 1 (when the bill is generated there is a payment amount on the bill)).

Claim 10. Speiser and Buckley failed to disclose, The method of claim 3 in which the at least one parameter is an option parameter of the requested payment, the method including identifying, in the computer system, that a hand-drawn mark has been entered on the bill by means of the pen and effecting, in the computer system, an operation associated with the option parameter. Perazza discloses, The method of claim 3 in which the at least one parameter is an option parameter of the requested payment, the method including identifying, in the computer system, that a hand-drawn mark has been entered on the bill by means of the pen and effecting, in the computer system, an operation associated with the option parameter (col. 16, lines 55-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the at least one parameter is an option parameter of the requested payment, the method including identifying, in the computer system, that a hand-drawn mark has been entered on the bill by means of the pen and effecting, in the computer system, an operation associated with the option parameter and to modify in Speiser because such a modification would allow Speiser to identify that a hand-drawn mark was present on the bill and made by a sensing device (pen).

Claims 11 and 38. Spieser discloses, the option parameter is associated with at least one of: cardholder name, payment method or credit card type (Page 8, paragraph 2 –payment method which can be any type of method).

Claim 12. Speiser and Buckley failed to disclose, The method of claim 3 entered by means of the pen and effecting, in the computer system, an operation associated with the text parameter. Perazza discloses, The method of claim 3 entered by means of the pen and effecting, in the computer system, an operation associated with the text parameter (col. 16, lines 55-63).

Claim 13. Speiser and Buckley failed to disclose, The method of claim 12 which includes converting, in the computer system, the handwritten text data to computer text. Perazza discloses, The method of claim 12 which includes converting, in the computer system, the handwritten text data to computer text (col. 16, lines 55-63).

Claims 14 and 39. Speiser and Buckley failed to disclose, the text parameter is associated with at least one of: a cardholder name, an amount paid or a card expiry date. Perazza discloses, the text parameter is associated with at least one of: a cardholder name, an amount paid or a card expiry date (col. 16, lines 28-63).

9. Claims 15-18 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser, (WO 99/66441) Buckley et al, hereafter Buckley, and (US 5,326,959) Perazza in view of (US 5,892,824) Beatson et al, hereafter Beatson.

Claim 15. Speiser, Buckley and Perazza failed to disclose, The method of claim 3 in which the at least one parameter is an authorization parameter of the requested payment, the method including identifying, in the computer system, that a handwritten signature has been entered by means of the pen and effecting, in the computer system, an operation associated with the authorization parameter. Beatson discloses, The method of claim 3 in which the at least one parameter is an authorization parameter of

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the requested payment, the method including identifying, in the computer system, that a handwritten signature has been entered by means of the pen and effecting, in the computer system, an operation associated with the authorization parameter (col. 8, lines 41-52).

Claim 16. Speiser, Buckley, and Perazza failed to disclose, The method of claim 15 which includes verifying, in the computer system, that the signature is that of a particular person. Beatson discloses, The method of claim 15 which includes verifying, in the computer system, that the signature is that of a particular person (col. 8, lines 41-52).

The Speiser, and Perazza patents lack a system that identifies that a handwritten signature has been entered by the sensing device and effecting the operation associated with the authorization parameter in claim 15 and the signature is that of a particular person in claim 16. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser and Perazza systems to include the teachings of the Beatson patent to make the systems more user friendly, faster, more efficient, and more secure.

Claims 17 and 40. Speiser and Buckley failed to disclose, the authorization parameter is associated with payment authorization. Perazza discloses, the authorization parameter is associated with payment authorization (col. 16, lines 28-63).

Claim 18. Speiser failed to disclose, The method of claim 1, wherein the providing step includes receiving a request from a user to print the bill on demand, and printing the bill on demand. Perazza discloses, wherein the providing step includes receiving a request

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from a user to print the bill on demand, and printing the bill on demand (col. 6, lines 53-65).

10. Claims 20-28 and 36, 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser, (WO 99/66441) Buckley et al, hereafter Buckley, (US 5,326,959) Perazza, (US 5,892,824) Beatson et al, hereafter Beatson,, (W0 99/50787) Xerox, (US 5,673,430) Story, (US 5,673,430) Mallicoat, and (10/94562A) Japanese Patent Abstract (Solution Portion of Abstract).

Claims 20 and 45. Speiser, Buckley, Perazza, and Beatson failed to disclose, wherein the coded data is invisible. Xerox discloses, wherein the coded data is invisible (Page 8, lines 23-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the coded data to be invisible and to have modified the Speiser, Buckley, Perazza, and Beatson patents to have invisible data so as not to interfere with other visible markings on the bill.

Claim 21. Speiser and Buckley failed to disclose, The method of claim 1 which includes retaining a retrievable record of each bill generated, each of the generated bills being receivable using its identity as contained in its coded data. Perazza discloses, The method of claim 1 which includes retaining a retrievable record of each bill generated, each of the generated bills being receivable using its identity as contained in its coded data (col. 6, lines 53-65).

Claim 22. Speiser, Perazza, Beatson, and Xerox failed to disclose, The method of claim 1 which includes distributing a plurality of the bills using a mixture of multicast and

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pointcast communications protocols. Story discloses, The method of claim 1 which includes distributing a plurality of the bills using a mixture of multicast and pointcast communications protocols (col. 3, lines 14-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, Perazza, Beatson, and Xerox patents to use multicast and pointcast communications protocols to reduce the operating costs.

Claims 23 and 42. Speiser, Perazza, Beatson, Xerox, and Story failed to disclose, the sensing device contains an identification means which imparts a unique identity to the pen and identifies it as belonging to a particular person and in which the method includes monitoring, in the computer system, said identity. Mallicoat discloses, the sensing device contains an identification means which imparts a unique identity to the pen and identifies it as belonging to a particular person and in which the method includes monitoring, in the computer system, said identity (col. 6, line 66-col. 7, line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, Buckley, Perazza, Beatson, Xerox, and Story patents to include the teachings of the Mallicoat patent to provide a more accurate and informative reading from the bill.

Claim 24. Speiser and Buckley failed to disclose, The method of claim 1 which includes providing all required information relating to the requested payment in the bill to eliminate the need for a separate display device. Perazza discloses, The method of claim 1 which includes providing all required information relating to the requested

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payment in the bill to eliminate the need for a separate display device (col. 6, lines 62-66).

Claims 25 and 47. Speiser, Buckley, Perazza, Beatson, Xerox, Story, and Mallicoat failed to disclose, the bill is printed on multiple pages and in which the method includes binding the pages. Japanese Patent Abstract discloses, the bill is printed on multiple pages and in which the method includes binding the pages (Solution Portion of Abstract).

Claim 26. Speiser and Buckley failed to disclose, The method of claim 1 wherein: the step of providing the bill is done by sending the bill by mail. Perazza discloses, The method of claim 1 wherein: the step of providing the bill is done by sending the bill by mail (col. 3, lines 53-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, Buckley, Perazza, Beatson, Xerox, Story, and Mallicoat patents to have a means of binding a bill having multiple pages so that the various pages would remain together and reduce the opportunity for the pages to become separated or lost.

Claim 27. Speiser and Buckley failed to disclose, The method of claim 1, further including the step of causing a printer to print a payment receipt after a payment has been completed. Perazza discloses, The method of claim 1, further including the step of causing a printer to print a payment receipt after a payment has been completed (col. 6, lines 53-65).

Claims 28 and 44. Speiser and Buckley failed to disclose, wherein the payment receipt comprises coded data indicative of the identity of the receipt. Perazza discloses,

wherein the payment receipt comprises coded data indicative of the identity of the receipt (col. 6, lines 53-65).

Claim 36. Speiser and Buckley failed to disclose, The system of claim 29 in which said at least one parameter of the requested payment is selected from the group comprising an action parameter of the requested payment, an option parameter of the requested payment, a text parameter of the requested payment, or an authorization parameter of the requested payment. Perazza discloses, The system of claim 29 in which said at least one parameter of the requested payment is selected from the group comprising an action parameter of the requested payment, an option parameter of the requested payment, a text parameter of the requested payment, or an authorization parameter of the requested payment (col. 16, lines 28-48).

Claim 41. Speiser, Buckley, Perazza, and Beatson failed to disclose, The system of claim 31 in which the pen includes a marking nib. Xerox discloses, The system of claim 31 in which the pen includes a marking nib (505, Page 14, lines 10-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, Perazza, and Beatson patents to have a pen with a nib so that if marks are necessary on the bill, they can be made at the time of reading the bill with the sensing device.

Claim 43. Speiser and Buckley failed to disclose, The system of claim 29 in which the bill is printed on a surface of a surface defining means and in which the system includes a printer for printing the bill on demand. Perazza discloses, The system of claim 29 in

which the bill is printed on a surface of a surface defining means and in which the system includes a printer for printing the bill on demand (col. 6, lines 53-65).

Claim 46. Speiser and Buckley failed to disclose, The system of claim 29 which includes a database for keeping a retrievable record of each bill generated, each bill being retrievable by using its identity as included in its coded data. Perazza discloses, The system of claim 29 which includes a database for keeping a retrievable record of each bill generated, each bill being retrievable by using its identity as included in its coded data (col. 7, lines 9-23).

Response to Arguments

11. Applicants' arguments filed 10/30/06 have been fully considered but they are not persuasive. Issue no. 1: Applicants' argue: There is nothing in Speiser that reads onto coded data indicative of a plurality of locations on the bill," the second identification symbol taught by Speiser is evidently not an indication of a plurality of locations on the bill, and nothing indicating the position of an optically imaging pen relative to Speiser's form has been considered but is not persuasive.

Response: Applicant's are arguing the amendment to claims 1 and 29 which was not addressed in the previous Office Action. Also the other claim limitations argued are the amendments in the response to the previous Office Action which the Examiner did not have an opportunity to address until now.

Inquiries

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.


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The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 16, 2007


ELLA COLBERT
PRIMARY EXAMINER